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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,982	03/28/2005	Akira Kakizuka	2005_0199A	1176
513 7590 12/10/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER SINGH, ANOOOP KUMAR				
ART UNIT		PAPER NUMBER		
1632				
MAIL DATE		DELIVERY MODE		
12/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/523,982

**Applicant(s)**

KAKIZUKA ET AL.

**Examiner**

ANOOP SINGH

**Art Unit**

1632

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 4-9.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Valarie Bertoglio/  
Primary Examiner, Art Unit 1632

Continuation of 3. NOTE: The amendments to proposed claim 7 raise new issues that require further search and consideration. Applicant has amended claims 7 to recite a method step wherein contacting candidate compound increases the activity for expressing the MCAD gene to the "same as or a higher" level than the control sample in a compound that increases the activity of ERR (step 4 of claim 7), a limitation that was not previously required. The amendments change the scope of method steps of proposed claim 7 and therefore requires new search and consideration for new matter and art purposes.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claims 4-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegelman et al (US Patent publication no. 2003/0124598, dated 7/3/2003, effective filing date 11/09/2001, IDS) and Huss et al (The Journal of Biological Chemistry 277, 43, 40265-40274) or (Biochemical and Biophysical Research Communications, 2002, 299, 872-879). It is noted that applicants have perfected the priority of JP2002/231999, August 8, 2002, thereby overcoming the rejection of record.

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner maintains the rejection of claims 4-9 for the reasons of record. Applicants' arguments based on the proposed amendments are not persuasive, because the claim amendments have not been entered and require new consideration and search.

Claims 4-9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegelman et al (US Patent publication no. 2003/0124598, dated 7/3/2003, effective filing date 11/09/2001, IDS), Vega et al (Dissertation Abstracts International, (1999) Vol 60, No. 9B, p. 4366)/ Vega et al (Mol Cell Biol. 2000 March; 20(5): 1868-1876) and Saldek et al (Molecular and Cellular Biology, 1997, 5400-5409). Applicants assert that English translation of JP2002/231999 has been submitted with this response. Therefore, the claim for foreign priority has been perfected. Applicants argue that filing date 8/8/2008 removes Spiegelman et al. (published July 3, 2003), Huss et al. (published August 13, 2002) and Henschke et al. (published October 2002) as prior art. Therefore, these rejections are overcome.

To the extent arguments apply to the pending claims, applicant arguments filed on 11/10/2008 have been fully considered but they are not persuasive. The effective filing date of Spiegelman et al (US Patent publication no. 2003/0124598, dated 7/3/2003, effective filing date 11/09/2001, IDS) is 11/9/2001 and not July 3, 2003 as argued by the applicants. In the instance case, Spiegelman et al (US Patent publication no. 2003/0124598, dated 7/3/2003, filed on 11/8/2002) takes priority from US provisional 60/338,126 filed November 9, 2001 and the claimed embodiments were disclosed in both applications '598 and '126. In absence of any other argument, rejection of record is maintained.

Claims 7-9 remain rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps for the reasons of record. Applicant's arguments based on the proposed amendments are not persuasive, because the claim amendments have not been entered and require new consideration for new matter and search for art purposes.

Anoop Singh  
AU 1632